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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,149	04/30/2001	John R. Bugarin	35010.126	3114

32827 7590 03/04/2004

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EXAMINER

HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,149

Applicant(s)

BUGARIN ET AL.

Examiner

Jennifer I. Harle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-39 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.5.6.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-39 are pending. Claims 1-39 are rejected.

Lexicography

After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant(s) to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)(“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).²

However, if Applicant(s) wish to use lexicography and desire a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

² See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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Applicant(s) in their next response to expressly indicate³ the claim limitation at issue⁴ and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).⁵ The Examiner cautions that no new matter is allowed.

Failure by Applicant(s) in their next response to address this issue or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) to forgo lexicography in this application and to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner’s position that above requirements are reasonable.⁶ Applicant(s) are also cautioned that even

³ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

⁴ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

⁶ The requirements are reasonable on at least two separate and independent grounds: first, the Examiner’s requirements are simply an express request for clarification of how Applicant(s) intend their claims to be interpreted. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with

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though claim interpretation begins with this presumption, after issuance the prosecution history may further limit claim scope if Applicant(s) disclaim or disavow a particular interpretation of the claims during prosecution. *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles apply to all examined claims currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 14-18, 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Turpin, et al. (5,008,810).

Turpin discloses a software system, server system, and method of operating a server system for directing product selection over a communication network and displays corresponding screens to a user, the user provides user inputs to the user system in response to the screens, the user system transfers corresponding user input signals over the communication network, and the screens are arranged in a sequence (cols. 14-17, lines 36-30 – Modes of Operation and Form Completion) the software/server system/method of operating a server system comprising:

Processing user data from the user input signals to determine if the user data is consistent data that is consistent with at least one of a plurality of products (cols. 14-17, lines 36-30 – “truth

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maintenance” which it transferred to main memory and the form system maintain any dependencies related to external sources of data linked to the forms and modifies the database and updates any fields linked to the database, and determination of meeting basic premium amount);

Processing user screen selections from the user input signals, transfer a selected one of the screen signals corresponding to a selected one of the screens if the selected one of the screens is backward in the sequence or if all previous ones of the screen in the sequence prior to the selected one of the screen have the consistent data, and to transfer to the user system over the communication network an earliest one of the screen signals corresponding to an earliest one of the screens in the sequence that does not have the consistent data if the selected one of the screen is forward in the sequence and if the previous ones of the screen in the sequence prior to the selected one of the screens do not all have the consistent data (cols. 14-17, lines 36-30 – for example, In the Life Insurance Application example, when the operator enters the applicant’s name, the system automatically looks in a database file for information about the applicant ... if information about the applicant is found in the database file ... it is retrieves from the file and the system automatically skips those fields ... if not the system prompt the operator for this information ... upon entry of a value for any field, the system automatically prompts entry into the next field according to the goal sequence ... as values are entered into the prompted fields automatic prompting may continue on the initial goal form to complete that form; or dependent on the values entered in certain field, prompting may digress ...; see also cols. 3-4, lines 57-9); and

A storage system that stores the user data software and the screen control software (Fig. 3 – Application Program; col. 2, lines 33-67).

Claims 2, 15, and 28 are rejected for the same reasons as the processing step set forth above.

As per claims 3, 16, and 29, Turpin discloses removing products that are inconsistent with the consistent data and modifying screen signals to indicate user data selections that are inconsistent with selectable ones of the products that remain under product selection (cols. 14-17, lines 36-30 – the premium amount is adjusted based upon the various answers, i.e. products are removed, lower or higher premium products that are inconsistent with the consistent data and the modifying signals is a no for the insured not meeting the basic requirements for the product itself).

As per claims 4, 17, and 30, Turpin discloses that processing system can start with a pre-existing set of the consistent data (Abstract; col.2, lines 33-67, cols. 14-17, lines 26-30 – can also force the system to propagate fields and calculate premium based upon basic assumptions and then go back).

As per claims 5, 18, and 31, Turpin discloses the ability to direct the system to complete a purchase transaction for a selected one of the products (col. 17, lines 22-31).

Claims 1, 14, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Puri (6,064,982).

Puri discloses a smart configurator that assists in the assessment, product/options selection, pricing, and distribution by recommending a system configuration that most nearly meets the customers needs based upon the results on an interactive dialog with the customer

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through a series of cascading style sheets. Puri further discloses that the smart configurator is run through a computer network and utilizes a computer program that stores user data software and screen control software (col. 3, lines 24-49). Puri additionally discloses that the various modules are linked pages that allow a user to move throughout a dialog in a coordinated fashion, such that the completion of any phase in the dialog automatically leads to a next phase and automatically passes information obtain during all previous phases to the present phase of the dialog, i.e. information captured in a form is automatically entered into subsequent forms as appropriate (Abstract; col. 1, lines 45-60, cols 2-3, lines 28-49). Puri also discloses that each page of the smart configurator may also include such controls and a select bar, a go to bar, a back button, a next button, and a cancel button (col. 4, lines 46-58). Puri moreover discloses a needs identification page and proposal template for configuring the product that most closely matches the product requested (cols. 5-6).⁷ Puri discloses that the software/network is configured to start with SKUs, i.e. pre-existing sets of consistent data (Fig. 11 and col. 6, lines 27-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-13, 19-26, and 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turpin, et al. (5,008,810) or Puri (6,064,982).

⁷ The examiner has interpreted the "or" in the second clauses of the independent claims to be separate aspects of the claimed invention.

Turin, et al or Puri disclose as set forth above. However, neither disclose that the products comprise flow meters, Coriolis flow meters, densitometers or that the user data indicates a fluid name, at least one of a fluid flow rate, fluid density, fluid viscosity, fluid pressure, and fluid temperature or that the user data indicate a flowmeter sensor type, flowmeter process connection type or flowmeter transmitter type. However, the specific products and user data associated with them does not patentably distinguish the claimed system/method because each product would have different data associated with it and each patent teaches applicability to multiple products. Thus product and the user data would be performed the same regardless in a software system for directing product selection over a communication network/a server system for directing product selection over a communication network or a method of operating a server system for directing product selection over a communication network, all involving receipt of screen signals and displays corresponding screens to users. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize any type of product and associated user data for the product because such product information and related user data does not functionally relate to the steps in the systems and method claimed and merely labeling the data differently from the prior art would have been obvious. See *Gulack* cited above.

Claim1-5, 14-18, and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri as applied to claim1, 14, and 27 above, and further in view of Mittal (6,233,609 B1).

Assuming arguendo that the “or” does not mean to separate patentably distinct segments of the second clause of claims 1, 14, and 27, Puri does not explicitly disclose what to do about consistent or inconsistent data. Mittal teaches that the configurator insures that the client’s choices are applied correctly so as to negate any conflict or impossibility that may arise from the client’s directives. Mittal additionally teaches that product is configured at the customer’s leisure and allows him to place an order for the figured product at any desired time by downloading the applet, i.e. the consistent data is transferred as there is no ability to have inconsistent data (col. 6, lines 15-20). Mittal further teaches that the customer can complete and place his order, i.e. purchase transaction (col. 6, lines 23-26). Mittal discloses moreover that the GUI interface produces an option where a customer does not need to do any significant downloading in order to configure and present an order to a company as complete configuration and transaction of an order takes place on-line and updates to customer software minimized as only GUI updates are required when significant editing is done to an existing GUI and such updates can occur through push technology (col.7, lines 25-37). Thus, Mittal discloses the ability to remove products that are non-selectable as inconsistent with the consistent data, the ability to start with pre-existing set of consistent data, and the ability to complete a purchase transaction for a selected one of the products. Mittal also discloses that computer-aided sales presentations utilizing rules-based configurators have long been a valuable tool for allowing a client to configure and order a product over a network to seller which can fill the order and that object-oriented, constraint-based configurators have begun to replace rules-based configurators due to their more flexible organization and ability to utilize a run-time engine that insures that the client’s choice are applied correctly in order to configure a product to reflect the desired specifications and features

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which are offered (cols. 1-2. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a transfer mechanism for the consistent data and the earlier screen, remove the non-selectable products, start with a pre-existing set of the consistent data and complete a purchase transaction in Puri as that is what configurators are known to do as set forth in Mittal and because it optimizes the configurator by maximizing the amount of correct data that is input and reduces the number of errors that the customer is likely to make thus, ensuring customer satisfaction with the product ordered and reducing the likelihood of product returns and increasing profitability.

Claims 6-13, 19-26, and 32-39 are rejected for the same reasons set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

<http://web.archive.org/web/19990830121410/commerce.us.dell.com>, archived August 30, 1999, printed February 17, 2004, pp. 1-4.

<http://www.autobytel.com>, printed April 11, 2000, pp.1-4.

<http://www.gmbuypower.com>, printed April 11, 2000, pp. 1-11. The examiner notes that on the current build your own web pages, they are a screen by screen, with maneuverability back and forth and option selections deleted or warnings issued about compatibility. The archival system does not allow for retrieval of this option.

<http://carpoint.msn.com>, printed April 11, 2000, pp. 1-7 discloses a primary screen about cars, a secondary screen where you choose your make and model along with a zip code, a third screen with further options, a fourth screen with more options, and a fifth screen so that a dealer

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can contact you. However, it is unknown what is happening with the options, i.e. whether it only discloses those options available – consistent data, or all options that would be available whether or not on this model.

<http://www.ford.com>, printed September 30, 1999, pp. 1-10. The examiner notes that on the current build your own web pages, they are a screen by screen, with maneuverability back and forth and option selections deleted or warnings issued about compatibility. The archival system does not allow for retrieval of this option.

Hall (US 2002/0133433 A1) discloses a method and system for multi-dynamic product configuration.

Day (US 2002/0128933 A1) discloses an interactive method and apparatus for product customization and purchase.

Palmer (US 2002/0107763 A1) discloses a web based system and method for configuring and determining availability of products.

Gamage, et al. (US 2002/0099597 A1) discloses a method for analyzing an assortment of retail products.

Jerry Edgerton, Made to Measure, Money, vol. 28, no. 12, December 1999, pp. 237-239 discloses that factory ordering online by make, model and options can save a customer money over dealership prices.

Homewarehouse.com to Showcase Product Wizard Technology at Demo 2000, PR Newswire, February 7, 2000, pg. 3734 discloses their product wizard.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their

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lawyers: that patent examiners are abysmal communicators, both orally and in writing,”⁸ the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁹ the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner’s position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner’s positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.¹⁰ By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

⁸ Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

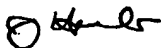
⁹ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.

¹⁰ See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Ione Harle
March 1, 2004